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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,357	06/19/2001	Lothar K. Faber	A7694	9655

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,357

Applicant(s)

FABER, LOTHAR K.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003 and 21 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7-9 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/2003 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendments (Paper Nos. 11 and 14) filed on 3/18/2003 and 4/21/2003.

It is noted that in the amendment (Paper No. 14) of 4/21/2003, applicant has amended claim 1 and added a new set of claims, i.e., claims 7-20, into the present application.

As amended and newly-added, the pending claims 1-20 are subjected to the following restriction.

Election/Restrictions

3. Claims 2-6 and the newly submitted claims 10-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

First, claims 1, 7-9 and 20, Group I, direct to a microscope having an objective housing for supporting a stereo objective and at least a compound objective

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wherein the objective housing is enable to swap the objectives into the viewing path of the microscope while such a mentioned feature is missing from the microscope recited in the claims 2-6 and 10-19, Group II. The recitation of the feature(s) in one group and not in the other group will require searches in different subclasses of class 359, and thus has resulted in a burden in the examiner part.

Second, the combination, Group II, as claimed does not set forth the details of the subcombination, Group I, as separately claimed and the subcombination has separate utility. Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination, Group I, in the combination, Group II, is evidence that the patentability of the combination does not rely on the details of the specific subcombination. See MPEP, Section 806.05©, element (I).

Since the present application is refiled under Rule 37 C.F.R. 1.114 and applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2-6 and 10-19 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

4. The substitute drawings filed on 7/2/2002 and 3/18/2003 were received by the Office. These drawings are disapproved by the Office draftsman for the reasons set forth in the attached form PTO-948.

Specification

5. A substitute specification without the claims is required pursuant to 37 CFR 1.125(a) because the interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 7-9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehr et al (U.S. Patent No. 4,697,893, submitted by applicant) in view of Koyama et al (U.S. Patent No. 6,226,118, of record).

Fehr et al disclose a microscope system having an objective lens changer (10), a microscope body (6) for supporting optical elements such as an image variable magnification system (21 and 22) and another microscope body (7) for

supporting other optical components such as a prism system (23) and an eyepiece system (25). See columns 2-3 and figs. 1-2. The objective lens changer (10) as described in columns 3-4 comprises a plate (11) supporting two different objective lens systems including a stereoscopic objective lens system (8) and a binocular lens system (9). The slide (11) is able to swap the stereoscopic objective lens system (8) with the binocular objective lens system (9) and vice versa. See column 3, lines 45+ through column 4, line 38). The only feature missing from the microscope provided by Fehr et al is that they do not disclose that the microscope has an illumination system comprises a light transmitted system and a fluorescent system. However, the use of a microscope system having such an illumination system wherein the microscope comprises a mechanism for switching different kind of objective lens systems into the viewing path of a microscope is clearly suggested to one skilled in the art as can be seen in the system provided by Koyama et al. For instance, in the embodiment described in column 14 and shown in figure 12, Koyama et al disclose a microscope having an illumination system comprises 1) a light transmitting illumination (63) for providing a bright illuminating pattern to an object, and a fluorescent illumination system (56) for providing excited light to activate fluorescent illumination in the object, and 2) a mechanism (8) supporting different objective lens systems in which a particular objective lens system is selectably inserted into the viewing path of the microscope. The switching operation of the selective objective lens system into the viewing path of the microscope could be

made in an automated fashion via a motorized system. See column 14. It is also noted that the use of rotatable turret/revolving supporting different objective lens systems is also suggested by Koyama et al as can be seen in the embodiments described in columns 11-12 and shown in figures 8 and 11a, for example. It is also noted that the use of a slider or a turret for supporting more than two objective lens systems is also known to one skilled in the art. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope having an objective lens changer provided by Fehr et al by using an illumination system having both a light transmitted illumination system and a fluorescent illumination system, and a motorized mechanism as suggested by Koyama et al for the purpose of automation the switching of the different objective lens systems in either a bright illumination or a fluorescent illumination.

Response to Arguments

8. Applicant's arguments with respect to claim 1 as provided in the amendment (Paper No. 11) of 3/18/2003 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are cited as of interest in that the U.S. Patent No. 6,069,734 discloses a microscope having an illumination system and an objective lens changer; and the U.S. Patent No. 3,918,793 discloses a microscope

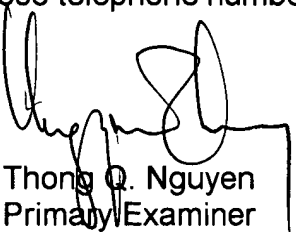
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having means for changing different optical elements wherein the means comprises either a slider or a rotatable turret.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

June 24, 2003